

### **REMARKS**

Claims 1-20 are pending in the present application. By this Amendment, new claim 20 has been added. Applicants respectfully request reconsideration of the present claims in view of the following remarks.

#### **I. Formal Matters:**

##### **Restriction Requirement:**

Applicants note the finality of the August 08, 2011 Restriction Requirement. Applicants further note with appreciation that original claim 8 has been rejoined with the claims of Group I previously elected in Applicants' September 08, 2011 Amendment and Response.

##### **Information Disclosure Statements**

Applicants note with appreciation that the references cited in the previously submitted July 20, 2006 and April 28, 2011 Information Disclosure Statements have been considered by Examiner Desai.

##### **Priority:**

Applicants have submitted herewith a substitute declaration/power of attorney (i.e., oath as referred to in the October 14, 2011 non-final Office Action) with the priority claim box correctly checked.

##### **Rejection of Previously Presented Claims 1-7 and 9 – Non-Statutory Double-Patenting**

Previously presented claims 1-7 and 9 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-11 of co-pending patent application no. 10/581,174 (hereinafter, "the '174 application"). This rejection is respectfully traversed.

Claims 9-11 of the '174 application are provided below:

9. A compound of formula I'



each R<sup>4</sup> is independently halogen, nitro, cyano, optionally substituted C<sub>1-6</sub> alkyl, optionally substituted C<sub>2-6</sub> alkenyl, optionally substituted C<sub>2-6</sub> alkynyl, optionally substituted alkoxy carbonyl, optionally substituted alkyl carbonyl, optionally substituted alkyl aminocarbonyl, optionally substituted dialkyl aminocarbonyl, optionally substituted C<sub>3-7</sub> cycloalkyl, optionally substituted aryl, optionally substituted heteroaryl, optionally substituted heterocyclyl, optionally substituted alkoxy, optionally substituted aryloxy, optionally substituted heteroaryloxy, optionally substituted alkylthio or R<sup>20</sup>R<sup>21</sup>N where R<sup>20</sup> and R<sup>21</sup> are, independently, hydrogen, C<sub>1-8</sub> alkyl, C<sub>3-7</sub> cycloalkyl, C<sub>3-6</sub> alkenyl, C<sub>3-6</sub> alkynyl, C<sub>3-7</sub> cycloalkyl(C<sub>1-4</sub>)alkyl, C<sub>2-6</sub> haloalkyl, C<sub>1-6</sub> alkoxy(C<sub>1-6</sub>)alkyl, C<sub>1-6</sub> alkoxy carbonyl or R<sup>20</sup> and R<sup>21</sup> together with the N atom to which they are attached form a five, six or seven-membered heterocyclic ring which may contain one or two further heteroatoms selected from O, N or S and which may be optionally substituted by one or two C<sub>1-6</sub> alkyl groups, or 2 adjacent groups R<sup>4</sup> together with the carbon atoms to which they are attached form a 4, 5, 6, or 7 membered carbocyclic or heterocyclic ring which may be optionally substituted by halogen;

n is 0, 1, 2, 3 or 4;

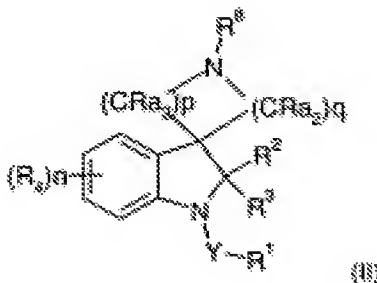
each  $R_a$  is independently hydrogen, halogen, hydroxy, cyano, optionally substituted  $C_{1-8}$  alkyl, optionally substituted  $C_{2-6}$  alkenyl, optionally substituted  $C_{2-6}$  alkynyl, optionally substituted alkoxy carbonyl, optionally substituted alkyl carbonyl, optionally substituted alkyl aminocarbonyl, optionally substituted dialkyl aminocarbonyl, optionally substituted  $C_{3-7}$  cycloalkyl, optionally substituted aryl, optionally substituted heteroaryl, optionally substituted heterocyclyl, optionally substituted alkoxy, optionally substituted aryloxy, optionally substituted heteroaryloxy, optionally substituted alkylthio, optionally substituted arylthio or  $R^{22}R^{23}N$  where  $R^{22}$  and  $R^{23}$  are, independently, hydrogen,  $C_{1-8}$  alkyl,  $C_{3-7}$  cycloalkyl,  $C_{3-6}$  alkenyl,  $C_{3-6}$  alkynyl,  $C_{3-7}$  cycloalkyl( $C_{1-4}$ )alkyl,  $C_{2-6}$  haloalkyl,  $C_{1-6}$  alkoxy( $C_{1-6}$ )alkyl,  $C_{1-6}$  alkoxy carbonyl or  $R^{22}$  and  $R^{23}$  together with the N atom to which they are attached form a five, six or seven-membered heterocyclic ring which may contain one or two further heteroatoms selected from O, N or S and which may be optionally substituted by one or two  $C_{1-6}$  alkyl groups, or two  $R_a$  groups on the same carbon atom are =O or two adjacent  $R_a$  groups are a bond, or two  $R_a$  groups together with the carbon to which they are bound form a three- to seven-membered ring, that may be saturated or unsaturated, and that may contain one or two hetero atoms selected from the group consisting of N, O and S, and which may be optionally substituted by one or two  $C_{1-6}$  alkyl groups; or two  $R_a$  groups together form a group  $-CH_2-$ ,  $-CH=CH-$  or  $-CH_2CH_2-$ ;

p is 0, 1, 2, 3, 4, 5 or 6; q is 0, 1, 2, 3, 4, 5 or 6; **provided that when p is 2 then q is not 2;**

p+q is 1, 2, 3, 4, 5 or 6;

$R^8$  is optionally substituted alkyl, optionally substituted alkenyl, optionally substituted alkynyl, optionally substituted cycloalkyl, optionally substituted aryl, optionally substituted alkoxy, optionally substituted aryloxy, optionally substituted alkoxy carbonyl, optionally substituted alkyl carbonyl or optionally substituted alkenyl carbonyl; or salts or N-oxides thereof provided that when n is 0, p is 1, q is 2,  $R^1$  is  $CH_3$  and all groups  $R_a$  are H then  $R^8$  is not H, methyl, benzyl or  $CH_2-CH=CH_2$  and when n is 0,  $(CRa_2)_p$  is CH-phenyl,  $(CRa_2)_q$  is  $(CH_2)_2$  and  $R^1$  is methyl then  $R^8$  is not  $COOCH_3$ .

10. A compound of formula II



wherein Y, n, p, q, R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, R<sup>4</sup> and Ra are as defined in claim 9 and R<sup>8</sup> is hydrogen or tert-butoxycarbonyl.

11. An insecticidal acaricidal and nematocidal composition comprising an insecticidally, acaricidally or nematocidally effective amount of a compound of formula I as defined in claim 1.

Applicants respectfully submit that claims 9-11 of the '174 application fail to teach or suggest Applicants' claimed invention as embodied in claims 1-7 and 9. In fact, claims 9-11 of the '174 application teach away from Applicants' claimed invention as embodied in claims 1-7 and 9.

Applicants note that independent claim 9 of the '174 application specifically recites that "when p is 2 then q is not 2." Consequently, the claimed compounds of independent claim 9 of the '174 application cannot comprise a piperidine ring or a pyridine ring with substituent R<sup>8</sup> positioned opposite (i.e., in a *para* substitution position) relative to the fused ring of the compounds, which is specifically required in the compounds of the present invention.

For at least the reasons given above, Applicants respectfully submit that claims 9-11 of the '174 application fail to make obvious Applicants' claimed invention as embodied in claims 1-7 and 9. Accordingly, withdrawal of this rejection is respectfully requested.

#### Rejection of Previously Presented Claims 1-7 and 9 – Non-Statutory Double-Patenting

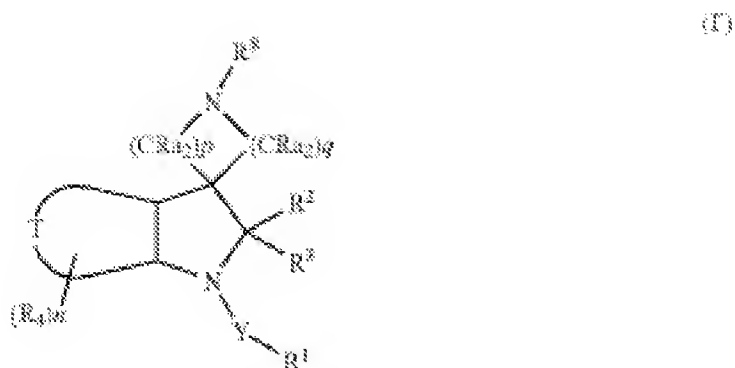
Previously presented claims 1-7 and 9 were also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of co-pending patent application no. 10/517,957. This rejection is moot given that co-pending patent application no. 10/517,957 was abandoned as of December 14, 2011 according to PAIR.

#### Rejection of Previously Presented Claims 1-7 and 9 – Non-Statutory Double-Patenting

Previously presented claims 1-7 and 9 were also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-11 of U.S. Patent No. 7,960,401 (hereinafter, "the '401 patent"). This rejection is respectfully traversed.

Claims 10-11 of the '401 patent are shown below:

10. A compound of formula II

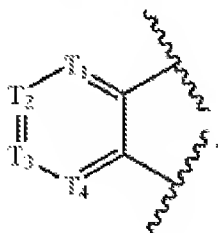


wherein Y is C=O, C=S;

R<sup>1</sup> is hydrogen, optionally substituted alkyl, optionally substituted alkoxy, optionally substituted alkylcarbonyl, aminocarbonyl, optionally substituted alkylaminocarbonyl, optionally substituted dialkylaminocarbonyl, optionally substituted aryl, optionally substituted heteroaryl, optionally substituted alkoxy, optionally substituted aryloxy, optionally substituted heteroaryloxy, optionally substituted heterocycloxy, cyano, optionally substituted alkenyl, optionally substituted alkynyl, optionally substituted cycloalkyl, optionally substituted cycloalkenyl, formyl, optionally substituted heterocyclyl, optionally substituted alkylthio, NO or NR<sup>13</sup>R<sup>14</sup> where R<sup>13</sup> and R<sup>14</sup> are independently hydrogen, COR<sup>15</sup>, optionally substituted alkyl, optionally substituted aryl, optionally substituted heteroaryl, optionally substituted heterocyclyl or R<sup>13</sup> and R<sup>14</sup> together with the N atom to which they are attached form a group -N=C(R<sup>16</sup>)-NR<sup>17</sup>R<sup>18</sup>; R<sup>15</sup> is H, optionally substituted alkyl, optionally substituted alkoxy, optionally substituted aryl, optionally substituted aryloxy optionally substituted heteroaryl, optionally substituted heteroaryloxy or NR<sup>19</sup>R<sup>20</sup>; R<sup>16</sup>, R<sup>17</sup> and R<sup>18</sup> are each independently H or lower alkyl; R<sup>19</sup> and R<sup>20</sup> are independently optionally substituted alkyl, optionally substituted aryl or optionally substituted heteroaryl; R<sup>2</sup> and R<sup>3</sup> are independently hydrogen, halogen, cyano, optionally substituted alkyl, optionally substituted alkoxy or optionally substituted aryl; **the ring**



**is a 6 membered heteroaromatic ring,**



**wherein T<sub>1</sub> represents N**, and each of T<sub>2</sub>, T<sub>3</sub>, and T<sub>4</sub> represent C;  
each R<sub>4</sub> is independently halogen, nitro, cyano, optionally substituted C<sub>1-8</sub> alkyl, optionally substituted C<sub>2-6</sub> alkynyl, optionally substituted C<sub>2-6</sub> alkynyl, optionally substituted alkoxy carbonyl, optionally substituted alkyl carbonyl, optionally substituted alkyl aminocarbonyl, optionally substituted dialkyl aminocarbonyl, optionally substituted C<sub>3-7</sub> cycloalkyl, optionally substituted aryl, optionally substituted heteroaryl, optionally substituted heterocyclyl, optionally substituted alkoxy, optionally substituted aryloxy, optionally substituted heteroaryloxy, optionally substituted alkylthio or R<sup>21</sup>R<sup>22</sup>N where R<sup>21</sup> and R<sup>22</sup> are, independently, hydrogen, C<sub>1-8</sub> alkyl, C<sub>3-7</sub> cycloalkyl, C<sub>3-6</sub> alkenyl, C<sub>3-6</sub> alkynyl, C<sub>3-7</sub> cycloalkyl (C<sub>1-4</sub>)alkyl, C<sub>2-6</sub> haloalkyl, C<sub>1-6</sub> alkoxy(C<sub>1-6</sub>)alkyl, C<sub>1-6</sub> alkoxy carbonyl or R<sup>21</sup> and R<sup>21</sup> together with the N atom to which they are attached form a five, six or seven-membered heterocyclic ring which may contain one or two further heteroatoms selected from O, N or S and which may be optionally substituted by one or two C<sub>1-6</sub> alkyl groups, or 2 adjacent groups R<sub>4</sub> together with the carbon atoms to which they are attached form a 4, 5, 6, or 7 membered carbocyclic or heterocyclic ring which may be optionally substituted by halogen;

R<sup>8</sup> is H or tert-butoxycarbonyl;

n is 0, 1, 2 or 3;

p is 0, 1, 2, 3, 4, 5 or 6;

q is 0, 1, 2, 3, 4, 5 or 6 provided that p+q is 1, 2, 3, 4, 5 or 6; and

R<sub>a</sub> is independently hydrogen, halogen, hydroxy, cyano, optionally substituted C<sub>1-8</sub> alkyl, optionally substituted C<sub>2-6</sub> alkenyl, optionally substituted C<sub>2-6</sub> alkenyl, optionally substituted alkoxy carbonyl, optionally substituted alkyl carbonyl, optionally substituted alkyl aminocarbonyl, optionally substituted dialkyl aminocarbonyl, optionally substituted C<sub>3-7</sub> cycloalkyl, optionally substituted aryl, optionally substituted heteroaryl, optionally substituted heterocyclyl, optionally substituted alkoxy, optionally substituted aryloxy, optionally substituted heteroaryloxy, optionally substituted alkylthio, optionally substituted arylthio or R<sup>23</sup>R<sup>24</sup>N where R<sup>23</sup> and R<sup>24</sup> are, independently, hydrogen, C<sub>1-8</sub> alkyl, C<sub>3-7</sub> cycloalkyl, C<sub>3-6</sub> alkenyl, C<sub>3-6</sub> alkynyl, C<sub>3-7</sub> cycloalkyl (C<sub>1-4</sub>)alkyl, C<sub>2-6</sub> haloalkyl, C<sub>1-6</sub> alkoxy(C<sub>1-6</sub>)alkyl, C<sub>1-6</sub> alkoxy carbonyl or R<sup>23</sup> and R<sup>24</sup> together with the N atom to which they are attached form a five, six or seven-membered heterocyclic ring which may contain one or two further heteroatoms selected from O, N or S and which may be optionally substituted by one or two C<sub>1-6</sub> alkyl groups, or two R<sub>a</sub> groups attached to the same carbon atom are =O or two R<sub>a</sub> groups attached to adjacent carbon atoms form a bond, or two R<sub>a</sub> groups together with the carbon atom to which they are attached form a three- to seven-membered ring, that may be saturated or unsaturated, and that may contain one or two hetero atoms selected from the group consisting of N, O and S, and which may be optionally substituted by one or two C<sub>1-6</sub> alkyl groups; or two R<sub>a</sub> groups together form a group -CH<sub>2</sub>-, -CH=CH- or -CH<sub>2</sub>CH<sub>2</sub>.

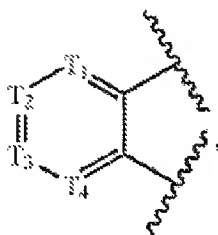
11. An insecticidal, acaricidal and nematocidal composition comprising an insecticidally, acaricidally or nematocidally effective amount of a compound of formula I' as defined in claim 9.

Applicants respectfully submit that claims 10-11 of the '401 patent fail to teach or suggest Applicants' claimed invention as embodied in claims 1-7 and 9. In fact, claims 10-11 of the '401 patent teach away from Applicants' claimed invention as embodied in claims 1-7 and 9.

Applicants note that independent claim 10 of the '401 patent specifically recites that "the ring



is a 6 membered heteroaromatic ring,



wherein T<sub>1</sub> represents N." Consequently, the claimed compounds of independent claim 10 of the '401 patent require the six-member ring to be a heteroaromatic ring, while the compounds of the present invention require the corresponding ring to be a phenyl ring.

For at least the reasons given above, Applicants respectfully submit that claims 10-11 of the '401 patent fail to make obvious Applicants' claimed invention as embodied in claims 1-7 and 9. Accordingly, withdrawal of this rejection is respectfully requested.

## II. Prior Art Rejections:

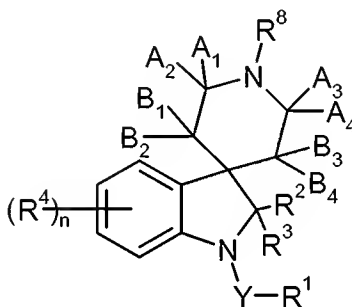
### Rejection of Previously Presented Claims 1-7 and 9-19 Under 35 U.S.C. §102(b) In View of Caplus English Abstract (AN 1952:57258 CAPLUS)

Previously presented claims 1-7 and 9-19 were rejected under 35 U.S.C. §102(b) as being anticipated by Caplus English Abstract (AN 1952:57258 CAPLUS) entitled "The Synthesis of a Physostigmine-like Compound" by Kretz et al. (hereinafter, "Kretz"). This rejection is respectfully traversed.

In order for the disclosure of Kretz to anticipate Applicants' claimed invention as embodied in independent claim 1, the disclosure of Kretz must disclose each and every claim feature recited in independent claim 1. See, for example, *Finnigan Corp. v. International Trade Commission*, 180 F.3d 1354, 1365, 51 USPQ2d 1001, 1009 (Fed. Cir. 1999), in which the Court stated "In order to establish anticipation, a prior art reference must disclose every feature of the claimed invention."

The disclosure of Kretz fails to disclose at least the following claim features recited in Applicants' independent claim 1:

- (1) a compound of the formula I:



wherein when  $B_1, B_2, B_3$  and  $B_4$  are all H, either both  $A_1$  and  $A_2$  are different from H or both  $A_3$  and  $A_4$  are different from H.

Applicants note that all of the compounds disclosed in Kretz, when compared with Applicants' formula I above, disclose each of  $A_1, A_2, A_3, A_4, B_1, B_2, B_3$  and  $B_4$  to be H; however, Applicants' claimed compounds as recited in Applicants' independent claim 1 require either both  $A_1$  and  $A_2$  to be different from H or both  $A_3$  and  $A_4$  to be different from H when  $B_1, B_2, B_3$  and  $B_4$  are all H.

For at least the reasons given above, the disclosure of Kretz cannot anticipate Applicants' claimed invention as embodied in independent claim 1. Since claims 2-7 and 9-19 depend from independent claim 1 and recite additional claim features, the disclosure of Kretz cannot anticipate Applicants' claimed invention as embodied in dependent claims 2-7 and 9-19. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejection of Previously Presented Claims 1-7 and 9 Under 35 U.S.C. §102(b) In View of English Abstract Ono Keiichi et (AN 1978:529425 CAPLUS)

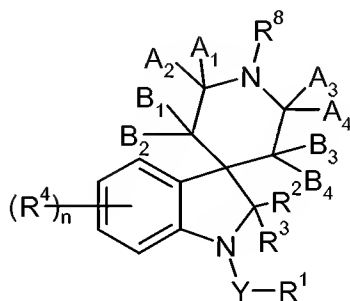
Previously presented claims 1-7 and 9 were rejected under 35 U.S.C. §102(b) as



being anticipated by English Abstract Ono Keiichi et (AN 1978:529425 CAPLUS) entitled “Spiroamine Derivatives” by Ono et al. (hereinafter, “Ono”). This rejection is respectfully traversed.

Like the disclosure of Kretz, the disclosure of Ono fails to disclose at least the following claim features recited in Applicants’ independent claim 1:

- (1) a compound of the formula I:



wherein when B<sub>1</sub>, B<sub>2</sub>, B<sub>3</sub> and B<sub>4</sub> are all H, either both A<sub>1</sub> and A<sub>2</sub> are different from H or both A<sub>3</sub> and A<sub>4</sub> are different from H.

Applicants note that the compound disclosed in Ono, when compared with Applicants’ formula I above, disclose each of A<sub>1</sub>, A<sub>2</sub>, A<sub>3</sub>, A<sub>4</sub>, B<sub>1</sub>, B<sub>2</sub>, B<sub>3</sub> and B<sub>4</sub> to be H; however, Applicants’ claimed compounds as recited in Applicants’ independent claim 1 require either both A<sub>1</sub> and A<sub>2</sub> to be different from H or both A<sub>3</sub> and A<sub>4</sub> to be different from H when B<sub>1</sub>, B<sub>2</sub>, B<sub>3</sub> and B<sub>4</sub> are all H.

For at least the reasons given above, the disclosure of Ono cannot anticipate Applicants’ claimed invention as embodied in independent claim 1. Since claims 2-7 and 9 depend from independent claim 1 and recite additional claim features, the disclosure of Ono cannot anticipate Applicants’ claimed invention as embodied in dependent claims 2-7 and 9. Accordingly, Applicants respectfully request withdrawal of this rejection.

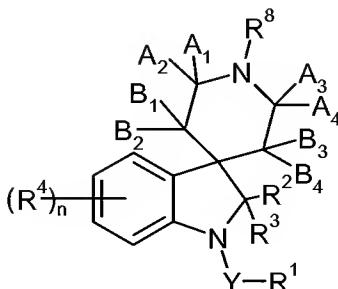
Rejection of Previously Presented Claims 1-7 and 9 Under 35 U.S.C. §102(b) In View of U.S. Patent No. 4,307,235 (Ong)

Previously presented claims 1-7 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,307,235 issued to Ong et al. (hereinafter, “Ong”). This rejection is respectfully traversed.

Like the disclosures of Kretz and Ono, the disclosure of Ong fails to disclose at

least the following claim features recited in Applicants' independent claim 1:

- (1) a compound of the formula I:



wherein when  $B_1$ ,  $B_2$ ,  $B_3$  and  $B_4$  are all H, either both  $A_1$  and  $A_2$  are different from H or both  $A_3$  and  $A_4$  are different from H.

Applicants note that the compound disclosed in Ong, when compared with Applicants' formula I above, disclose each of  $A_1$ ,  $A_2$ ,  $A_3$ ,  $A_4$ ,  $B_1$ ,  $B_2$ ,  $B_3$  and  $B_4$  to be H; however, Applicants' claimed compounds as recited in Applicants' independent claim 1 require either both  $A_1$  and  $A_2$  to be different from H or both  $A_3$  and  $A_4$  to be different from H when  $B_1$ ,  $B_2$ ,  $B_3$  and  $B_4$  are all H.

For at least the reasons given above, the disclosure of Ong cannot anticipate Applicants' claimed invention as embodied in independent claim 1. Since claims 2-7 and 9 depend from independent claim 1 and recite additional claim features, the disclosure of Ong cannot anticipate Applicants' claimed invention as embodied in dependent claims 2-7 and 9. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejection of Previously Presented Claims 1-19 Under 35 U.S.C. §102(b) In View of Meng-Hsin Chen (Chen)<sup>1</sup>

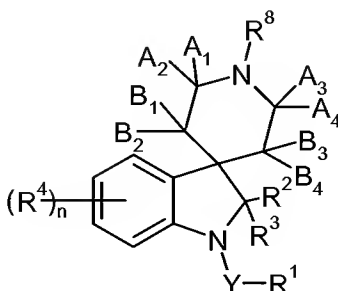
Previously presented claims 1-19 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,536,716 issued to Chen et al. or the *Tetrahedron Letters* article entitled "Free Radical Method for the Synthesis of Spiro-Piperidiny Heterocycles," volume 37, No. 30, pages 5233-5234 (1996) (hereinafter, "Chen"). This rejection is respectfully traversed.

Like the disclosures of Kretz, Ono and Ong, the disclosure of Chen fails to

<sup>1</sup> Applicants are uncertain whether this rejection is based on U.S. Patent No. 5,536,716 (Chen et al.) or Chen's *Tetrahedron Letters* article, volume 37, No. 30, pages 5233-5234 (1996) or some other Chen reference. However, the analysis is the same regardless of which Chen reference is being used in this rejection.

disclose at least the following claim features recited in Applicants' independent claim 1:

- (1) a compound of the formula I:



wherein when B<sub>1</sub>, B<sub>2</sub>, B<sub>3</sub> and B<sub>4</sub> are all H, either both A<sub>1</sub> and A<sub>2</sub> are different from H or both A<sub>3</sub> and A<sub>4</sub> are different from H.

Applicants note that the compounds disclosed in Chen, when compared with Applicants' formula I above, disclose each of A<sub>1</sub>, A<sub>2</sub>, A<sub>3</sub>, A<sub>4</sub>, B<sub>1</sub>, B<sub>2</sub>, B<sub>3</sub> and B<sub>4</sub> to be H; however, Applicants' claimed compounds as recited in Applicants' independent claim 1 require either both A<sub>1</sub> and A<sub>2</sub> to be different from H or both A<sub>3</sub> and A<sub>4</sub> to be different from H when B<sub>1</sub>, B<sub>2</sub>, B<sub>3</sub> and B<sub>4</sub> are all H.

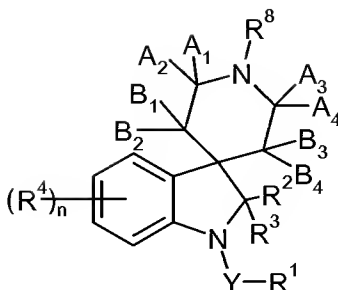
For at least the reasons given above, the disclosure of Chen cannot anticipate Applicants' claimed invention as embodied in independent claim 1. Since claims 2-19 depend from independent claim 1 and recite additional claim features, the disclosure of Chen cannot anticipate Applicants' claimed invention as embodied in dependent claims 2-19. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejection of Previously Presented Claims 1-7 and 9 Under 35 U.S.C. §102(b) In View of International Patent Application Publication No. WO94/29309 (Malcolm)

Previously presented claims 1-7 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by International Patent Application Publication No. WO94/29309 to Malcolm et al. (hereinafter, "Malcolm"). This rejection is respectfully traversed.

Like the disclosures of Kretz, Ono, Ong and Chen, the disclosure of Malcolm fails to disclose at least the following claim features recited in Applicants' independent claim 1:

- (1) a compound of the formula I:



wherein when B<sub>1</sub>, B<sub>2</sub>, B<sub>3</sub> and B<sub>4</sub> are all H, either both A<sub>1</sub> and A<sub>2</sub> are different from H or both A<sub>3</sub> and A<sub>4</sub> are different from H.

Applicants note that the compound disclosed in Malcolm, when compared with Applicants' formula I above, disclose each of A<sub>1</sub>, A<sub>2</sub>, A<sub>3</sub>, A<sub>4</sub>, B<sub>1</sub>, B<sub>2</sub>, B<sub>3</sub> and B<sub>4</sub> to be H; however, Applicants' claimed compounds as recited in Applicants' independent claim 1 require either both A<sub>1</sub> and A<sub>2</sub> to be different from H or both A<sub>3</sub> and A<sub>4</sub> to be different from H when B<sub>1</sub>, B<sub>2</sub>, B<sub>3</sub> and B<sub>4</sub> are all H.

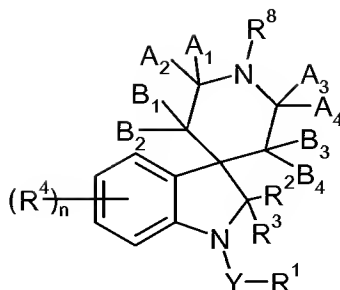
For at least the reasons given above, the disclosure of Malcolm cannot anticipate Applicants' claimed invention as embodied in independent claim 1. Since claims 2-7 and 9 depend from independent claim 1 and recite additional claim features, the disclosure of Malcolm cannot anticipate Applicants' claimed invention as embodied in dependent claims 2-7 and 9. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejection of Previously Presented Claims 1-7 and 9 Under 35 U.S.C. §102(e) In View of International Patent Application Publication No. WO03/106457 (Hughes)

Previously presented claims 1-7 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by International Patent Application Publication No. WO03/106457 to Hughes et al. (hereinafter, "Hughes"). This rejection is respectfully traversed.

Like the disclosures of Kretz, Ono, Ong, Chen and Malcolm, the disclosure of Hughes fails to disclose at least the following claim features recited in Applicants' independent claim 1:

- (1) a compound of the formula I:



wherein when  $B_1, B_2, B_3$  and  $B_4$  are all H, either both  $A_1$  and  $A_2$  are different from H or both  $A_3$  and  $A_4$  are different from H.

Applicants note that the compounds disclosed in Hughes, when compared with Applicants' formula I above, disclose each of  $A_1, A_2, A_3, A_4, B_1, B_2, B_3$  and  $B_4$  to be H; however, Applicants' claimed compounds as recited in Applicants' independent claim 1 require either both  $A_1$  and  $A_2$  to be different from H or both  $A_3$  and  $A_4$  to be different from H when  $B_1, B_2, B_3$  and  $B_4$  are all H.

For at least the reasons given above, the disclosure of Hughes cannot anticipate Applicants' claimed invention as embodied in independent claim 1. Since claims 2-7 and 9 depend from independent claim 1 and recite additional claim features, the disclosure of Hughes cannot anticipate Applicants' claimed invention as embodied in dependent claims 2-7 and 9. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejection of Previously Presented Claims 1-7 and 9 Under 35 U.S.C. §103(a) In View of Hughes

Previously presented claims 1-7 and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes. This rejection is respectfully traversed.

Applicants note that the teaching of Hughes is not prior art to Applicant's claimed invention under 35 U.S.C. §102(e) given that (1) the present application was filed after November 29, 1999, (2) the present application and Hughes were, at the time of the present invention, owned by the same person/entity (i.e., Syngenta Crop Protection, Inc.) or subject to an obligation of assignment to the same person/entity (i.e., Syngenta Crop Protection, Inc.), and (3) the American Inventors Protection Act (AIPA) disqualified any previous 102(e) art that met conditions (1) and (2) (e.g., Hughes). See, for example, the Manual Of Patent Examination Procedure (MPEP) §706.02(l)(1), in the subsection entitled "I. COMMON OWNERSHIP OR

ASSIGNEE PRIOR ART EXCLUSION UNDER 35 U.S.C. 103(c).”

For this reason alone, Hughes is not prior art to Applicant’s claimed invention under 35 U.S.C. §103(a). Accordingly, withdrawal of this rejection is respectfully requested.

III. New Claim 20:

New claim 20 depends from previously presented claim 13, and is directed to a specific embodiment of Applicants’ claimed invention. Support for new claim 20 may be found in at least the following locations of Applicants’ original specification: page 1, line 12 to page 3, line 8, page 4, lines 4-9, and original claim 10.

For at least the reasons provided above, Applicants submit that new claim 20 is allowable over the art. Accordingly, Applicants respectfully request allowance of this claim.

IV. Conclusion:

Applicants submit that claims 1-20 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

Should Examiner Desai believe that further action is necessary to place the application in better condition for allowance, Examiner Desai is respectfully requested to contact Applicants’ representative at the telephone number listed below.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Respectfully submitted,

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